



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

COPY MAILED

Paper No. 26

MAR 22 2000

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

In re Application of :
Mills et al. :
Application No. 09/009,294 : DECISION ON PETITION
Filed: January 20, 1998 :
For: HYDRIDE COMPOUNDS :

This is in response to three communications submitted on February 28, 2000, regarding the application No. 09/009,294, requesting that the Commissioner review the action of the Director, Special Programs Law Office, with respect to the withdrawal of this application from issue. Although the three letters fail to clearly identify the submissions as a formal petition under 37 CFR 1.181 requesting the Commissioner to invoke his supervisory authority, the submissions are being treated as a single petition under 37 CFR 1.181(a)(3). The three letters are: (1) a February 28, 2000, letter to the Commissioner; (2) a February 28, 2000, letter to Director Spar; and (3) a February 28, 2000, letter to Director Kepplinger.

The petition is denied.¹

BACKGROUND

A Notice of Allowance and Issue Fee due was mailed in the above-identified application October 18, 1999, which set a statutory period of three months to pay the issue fee.

On October 22, 1999, the PTO processed applicant's issue fee payment, and the application in due course was assigned a patent No. (6,030,601) and an issue date of February 29, 2000.

On February 15, 2000, U.S. Patent No. 6,024,935 (the '935 patent), titled "Lower Energy Hydrogen Methods and Structures," issued to the assignee Blacklight Power, Inc., which patent named Randell Mills et al. as the inventors.

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

On February 17, 2000, the Director of the Technology Center (Director) which had examined the application that issued as the '935 patent, learned that the '935 patent had issued.

Shortly thereafter, upon inspecting the '935 patent, the Director read, *inter alia*, that the invention therein was asserted to relate to the discovery that energy was released by stimulating hydrogen atoms to relax, and, in so doing, to shrink to smaller radii, and to also attain energy levels below their "ground state" according to a "novel atomic model." The Director was immediately struck by the assertion that the electron of a hydrogen atom could attain an energy level and orbit below the "ground state" corresponding to a fractional quantum number because such an assertion did not conform to the known laws of physics and chemistry. The Director was immediately aware that any pending application embodying such a concept raise a substantial question of patentability of one or more claims which would require reopening prosecution.

The Director further became aware that another pending application that embraced the above-noted contradiction to the known laws of chemistry and physics, was application 09/009,294 and that application was scheduled to issue as a patent on February 29, 2000.

In response to a request for prompt assistance from the Director in ensuring that the patent would not issue, the Director, Special Programs Law Office (SPLO) requested that the above-identified application be withdrawn from issue under 37 CFR 1.313 by the Office of Petitions, which resulted in the Notice to applicant mailed February 17, 2000.

Due to the lateness of the request of the Director, the PTO could not prevent the previously scheduled publication of the specification in the February 29, 2000, *Official Gazette*. Nevertheless, as the Notice of February 17, 2000, indicated that this application had been withdrawn from issue, the patent did not issue on February 29, 2000. See Harley v. Lehman, 981 F. Supp. 9, 44 USPQ2d 1699 (D.D.C. 1997). As is usual in such instances, an erratum notice was published in the *Official Gazette* on March 14, 2000.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § 6(a) provides, in part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. § 131 states:

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

37 CFR 1.313 states that:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. Any such petition by the applicant must include a showing of good and sufficient reasons why withdrawal of the application is necessary and, if the reason for the withdrawal is not the fault of the Office, must be accompanied by the fee set forth in § 1.17(i). If the application is withdrawn from issue, a new notice of allowance will be sent if the application is again allowed. Any amendment accompanying a petition to withdraw an application from issue must comply with the requirements of § 1.312.

(b) When the issue fee has been paid, the application will not be withdrawn from issue for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims;
- (4) For interference; or
- (5) For abandonment to permit consideration of an information disclosure statement under § 1.97 in a continuing application.

MPEP 1201 states in pertinent part that:

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of

opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter.

OPINION

Petitioner asks that the Commissioner intervene and consider the instant petition. As to the merits of the petition, petitioner contends that the withdrawal from issue was a clear error as authorized by the Director of the Special Programs Law Office, and points to the communication addressed to the Director of Technology Center 1700 which accompanies the petition in support of his assertions. Petitioner's short letters to the Commissioner and Director Spar appear to rest on the theory that no new issue of patentability arose. As noted below, this argument is without merit. The letter to Director Kepplinger, which accompanied the two former letters, merely requests a meeting with PTO personnel to discuss the application that was withdrawn.²

The decision of the Director to request withdrawal from issue to reopen prosecution of this application did not constitute either the rejection of a claim or a decision adverse to the ultimate patentability of a claim. See In re Voss, 557 F.2d 812, 816, 194 USPQ 267, 270 (CCPA 1977). The PTO will issue in due course either a supplemental notice of allowance or an office action rejecting the claims. If the claims are rejected, Petitioner will then have a full opportunity to rebut the PTO's decision, including ultimately an appeal on the patentability merits to the Board of Patent Appeals and Interferences.

² In the time period between submission of the petition and this decision, petitioner has been offered an opportunity to provide whatever information it chooses to submit to the PTO at an on-the-record Office Interview. However, petitioner has refused to participate in such a meeting although such a meeting was requested by petitioner.

While it is understandable that petitioner is concerned about the withdrawal from issue of the above-identified application, the record does not show that the SPLO has acted beyond the scope of its authority in promptly assisting with the request from the Director to secure the withdrawal of this application from issue, or, based on that request, authorizing the Notice of February 17, 2000, for the Technology Center's purpose of reopening prosecution. Rather, that assistance is specifically within the SPLO's purview.

Section 1.313(b) of 37 CFR specifically authorizes the PTO to withdraw an application from issue to reopen prosecution. See Harley v. Lehman, 981 F. Supp. 9, 11-12, 44 USPQ2d 1699, 1701-02 (D.D.C. 1997) (applications may be withdrawn from issue even after payment of the issue fee in situations wherein the Group Director seeks to reopen prosecution). The withdrawal Notice of which petitioner complains merely apprised petitioner of the fact of withdrawal, and further, served the purpose of returning jurisdiction of the application to the Technology Center. See MPEP 1302.

In reaching her decision, the Director read the specification of the '935 patent and noted, *inter alia*, that the shrunken, lower energy hydrogen atoms or "hydrinos," are asserted in the '935 patent to react with other atoms, such as those of metals, to produce hydrides, which are the compounds claimed in the application at issue. The principles set forth in the '935 patent are not known to the Director to be generally recognized by the scientific community, but rather, are indicated in the '935 patent to be the discovery of one of the above-named inventors who asserted to have built further on quantum mechanics and derived a new atomic theory based on "first principles." The '935 patent further claims that its "novel theory . . . unifies Maxwell's Equations, Newton's Laws, and Einstein's General and Special Relativity."³

The concept that hydrinos can be created by hydrogen atoms relaxed to below their "ground state," was recognized by the Director not to conform with the known laws of chemistry and physics that are embraced by the scientific community. This lack of compliance with the known laws of chemistry and physics reasonably caused the Director to request withdrawal from issue of the instant application due to the Director's determination that one or more claims lacked patentability.

³ In its petition, petitioner refers to its invention as "revolutionary technology."

Furthermore, an inspection of Application No. 09/009,294 reveals that this invention is asserted to matters containing fractional quantum numbers. Such fractional quantum numbers do not conform to the known laws of physics and chemistry. For instance (1) page 5, lines 10-20, (2) page 11, lines 14-30, (3) page 68, lines 21-35, and (4) claim 17, all pertain to fractional quantum numbers which are not known to conform to the known laws of physics and chemistry.

The application did not issue as a patent on February 17, 2000, and thus, it did not enjoy the statutory presumption of validity, including operability, that is reserved only for an issued patent, when the Director requested withdrawal from issue. See 35 U.S.C. § 282. As such, the Director was not prohibited from determining anew that the technology embraced by the instant application lacked patentability of one or more claims.

That is, in light of (1) the application pertains to the field of chemistry (see title: "Hydride Compounds") which is often unpredictable, (2) the statement noted above by the Director which pertains to how these compounds are produced by a chemical reaction involving a hydrogen atom in a state that is not recognized by the scientific community which (3) the Director discerned was, on its face, contrary to generally accepted scientific principles, the reasonableness of the Director's decision to request withdrawal from issue to reopen prosecution is apparent. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369-370 (CCPA 1971):

In the field of chemistry generally, there may be times when the well-known unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put forward as enabling support for a claim. This will especially be the case where the statement is, on its face, contrary to generally accepted scientific principles.

See also In re Chilowsky, 229 F.2d 457, 462, 108 USPQ 321, 325 (CCPA 1956):

Thus, in the usual case where the mode of operation alleged can be readily understood and conforms to the known laws of physics and chemistry, operativeness is not questioned, and no further evidence is required. On the other hand, if the alleged operation seems clearly to conflict with a recognized scientific principle as, for example, where an applicant purports to have discovered a machine producing perpetual motion, the presumption of inoperativeness is so strong that very clear evidence is required to overcome it.

Further, while petitioner complains that the Notice of February 17, 2000, does not set forth any "new" issues of mistake, violation of 37 CFR 1.56, or unpatentability of one or more claims, in support of the withdrawal, 37 CFR 1.313 does not require the issue(s) be "new" for the Director's request for withdrawal from issue to be proper. Petitioner assumes that once a single PTO employee agrees with an applicant, even erroneously, no further review within the PTO is warranted or legally possible. Such a belief is without merit. For example, an examiner is not precluded from reopening prosecution to reinstate a rejection that had been made earlier in prosecution and withdrawn. See In re Freeman, 166 F.2d 178, 180, 76 USPQ 585, 586 (CCPA 1948).⁴ See also 37 CFR 1.196(b) (Board of Patent Appeals and Interferences may enter grounds of rejection not contained in the examiner's final rejection when applicant appeals final rejection).

While petitioner in the accompanying letter points to favorable testimonials from scientists and entrepreneurs regarding the "revolutionary technology" that the instant application is asserted to embody, this does not establish that either the Director, Technology Center 1700, or the Director, Special Programs Law Office, committed reversible error, nor that the Notice should be withdrawn. In contrast, mainstream newspapers have reported this same "revolutionary technology" is accompanied by controversy in the scientific community. See Baard et al., Scientists and entrepreneurs have lots of ideas about new sources of energy; some may even be practical, Wall St. J., Sept. 13, 1999, at R16; Park, Perpetual motion: still going around, Washington Post, Jan. 12, 2000, at H3.

The PTO has an obligation to issue patents that meet the statutory requirements for patentability. 35 U.S.C. § 131. See also In re Schmidt, 377 F.2d 639, 641, 153 USPQ 640, 642 (CCPA 1967); Markman v. Westview Instruments, Inc., 52 F.3d 967, 985

⁴ In Freeman, the reopening of prosecution set forth, *inter alia*, a ground of rejection (double patenting) that had been made earlier in prosecution, but had not been repeated in the final rejection, and, as such, was not an issue considered in the first appeal. After this rejection was affirmed by the Board of Appeals in the second appeal, counsel for Freeman argued unsuccessfully to the court that the circumstances suggested that this ground of rejection had not initially been repeated due to its "doubtful propriety." The CCPA noted that the rejection was nevertheless properly before it for consideration on the merits, and likewise affirmed. Id.

n.14, 34 USPQ2d 1321, 1334 n.14 (Fed. Cir. 1995), aff'd, 116 S. Ct. 1384, 38 USPQ2d 1461 (1996). It would be contrary to sound public policy for the PTO to issue a possibly invalid patent. See Harley, 44 USPQ2d at 1701. When, as here, a "revolutionary technology" has been reported in the public record as being viewed with skepticism by two physicists of repute (including the 1997 Nobel co-laureate in physics, see Baard et al.) and further, another professor of physics (see Park) publicly asserts that such "revolutionary technology" does not conform with the known laws of physics and chemistry, it is reasonable for the PTO to withhold issuance to ensure that all the statutory requirements for a patent have been herein met.

While petitioner points to U.S. Patent No. 6,024,935 recently issued to Mills, the law is well settled that the issuance of that patent cannot operate to discharge the PTO's obligation with respect to the patentability *vel non* of the instant application. See In re Margaroli, 318 F.2d 348, 138 USPQ 158 (CCPA 1963); In re Wright, 256 F.2d 583, 118 USPQ 287 (CCPA 1958); In re Launder, 212 F.2d 603, 101 USPQ 391 (1954). Rather, such issuance is immaterial to, and does not undermine, the reasonableness of the request of the Director to seek withdrawal from issue to permit reopening of prosecution, see In re Giolito, 530 F.2d 397, 188 USPQ 645 (CCPA 1976), or the reasonableness of the action of the SPLO in implementing that request.

This conclusion of reasonableness on the part of the PTO *vis-a-vis* patentability is reinforced by the controversy surrounding this allegedly "revolutionary technology." As the PTO examines applications which embrace almost every field of endeavor, it is reasonable for the PTO to take appropriate steps to satisfy itself in the first instance, especially when a controversial "revolutionary technology" is involved, that the statutory requirements pertaining to the issuance of patents have been met. See generally Newman v. Quigg, 877 F.2d 1575, 11 USPQ2d 1340 (Fed. Cir. 1989); Ex parte Dash, 27 USPQ2d 1481 (BPAI 1992).

DECISION

A review of the record indicates that the Director, Special Programs Law Office, and the Director, Technology Center 1700, did not act improperly in withdrawing the application from issue. For the foregoing reasons, the withdrawal of the application from issuance is appropriate.

As such, the Notice of February 17, 2000, will not be rescinded. The above-identified application remains withdrawn from issue. An Office Action addressing the merits of the application or a supplemental Notice of Allowance will issue in due course.

This decision, as with all petitionable procedural matters, does not relieve or suspend applicant's obligation to continue prosecuting the patent application. 37 CFR 1.181(f) ("The mere filing of a petition will not stay the period of reply to an Examiner's action which may be running against an application, nor does it act as a stay of other proceedings."). In this application, no time limit is currently pending against applicant.



Stephen G. Kunin
Deputy Assistant Commissioner for
Patent Policy and Projects